

REMARKS

The invention of the present application relates to combinations of herbicides and safeners that are outstandingly suitable for use against competing harmful plants in crops of useful plants.

It is believed that no fee is required for the consideration of this Amendment. However, if an additional fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

This Amendment adds claims 13 to 21, amends claims 1, 4, 6, 7, and 9, and cancels claim 12 without prejudice, admission, surrender of subject matter, or intention of creating estoppel as to equivalents. Support for the added claims, which depend from claim 1 and are drawn to preferred embodiments, is found throughout the specification. Claims 1, 4, 6, 7, and 9 were amended to conform to U.S. practice. No new matter is added.

In response to the Restriction Requirement mailed on June 23, 2003, Applicants elect the herbicidal composition comprising herbicide 1-1 (see Table 1, pp. 29-30) and safener II-9 (ethyl 5,5-diphenyl-2-isoxazoline-3-carboxylate). Claims 1 to 3, 6 to 11, and 13 to 21 read on the elected species. The Restriction Required is traversed, and modification or withdrawal is requested in light of the following remarks.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP§803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants respectfully submit that the Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Searching and examination of the elected herbicide 1-1, for example, would be expected to overlap with subsequent expanded searches for additional members of the claimed genera that encompass the elected herbicide.

Moreover, Applicants submit that the Restriction Requirement is also improper if, once claims directed to the elected species are found allowable, examination is not expanded to generic claims that encompass the species. 37 C.F.R. 1.146.

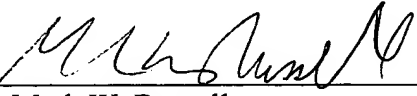
Finally, it is respectfully urged that the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining multiple patents is unreasonable in view of the fact that the present application represents a web of knowledge and continuity of effort that merits examination in a single application. Moreover, in view of the uncertain outcome of recursive examination starting with the elected species, Applicants will not be able to mitigate against shortened patent terms that may result from filing divisional applications in the future. Similarly, the public will not know whether non-elected inventions can be practiced without infringing future patent applications

Accordingly, in view of the foregoing, reconsideration and modification of this restriction requirement is requested and an early action on the merits is earnestly solicited.

Respectfully submitted,

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